



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/711,019

08/18/2004

Scott L. Nielson

5018

22913

7590

06/02/2006

WORKMAN NYDEGGER  
(F/K/A WORKMAN NYDEGGER & SEELEY)  
60 EAST SOUTH TEMPLE  
1000 EAGLE GATE TOWER  
SALT LAKE CITY, UT 84111

EXAMINER

HUSON, MONICA ANNE

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/711,019

Applicant(s)

NIELSON ET AL.

Examiner

Monica A. Huson

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant is advised that should claims 1-14 be found allowable, claims 15-28 will be objected to under 37 CFR 1.75 as being a substantial duplicates thereof, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### ***Claim Objections***

Claims 6 and 20 are objected to because of the following informalities: It is believed that the word “regards” should be in singular form (“regard”) relative to the surrounding sentence structure. Appropriate correction is required.

#### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the following claimed subject matter:

Claims 9 and 23: “allowing up to three inches in width, five inches in length and three inches in height for an individual nail object to be cut out of the manufactured nail blank, thus changing the parameters of the manufactured nail blank to allow for such an object to be successfully removed from it without damaging the nail objects characteristics or intruding upon any other number of individual nail objects to be removed from the manufactured nail blank.”

Claims 11 and 25: “any combination of these molding methods”

Claims 13 and 27: material “of the same type but may be distinguished by color, chemical properties, characteristics or other distinguishing factors”

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 5-9, 13, 15, 17, 19-23, 27 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The steps which go to make up the process must be clearly and positively specified. The process must be organized and correlated in such a manner as to present a operative method. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Specifically, the claims are indefinite and unclear in the following ways:

Claims 1 and 15: The claims contain the phrase “when applicable”. It is unclear whether applicant intends to claim the material following the above phrase as part of his invention. For purposes of examination, it will be interpreted that the phrase following “when applicable” is not required to be a step of the claimed method.

Claims 3 and 17: The claims contain two sentences. Note that claim(s) must be in one sentence form only. It is unclear whether applicant intends to claim the subject matter in the second sentence as part of his invention. For purposes of examination, it will be interpreted that subject matter in the second sentence is not required as part of the claimed invention.

Claims 5 and 19: The claims contain the phrase “a mold design that...appears to allow for the nail blank to permit a nail object to be cut...”. It is unclear whether applicant intends to claim a mold design that allows for the nail blank to permit a nail object to be cut as part of his invention. For purposes of examination, it will be interpreted that applicant intends to claim a

mold design that allows for the nail blank to permit a nail object to be cut as part of his invention. However, it is noted that the above limitation is listed in the alternative with another mold limitation, so the above limitation is still not necessarily required as part of applicant's invention.

Claims 6 and 20: The claims contain the phrase "the artistic enhancement may include...". It is unclear whether applicant intends to limit the claim to the material following the above phrase. For purposes of examination, it will be interpreted that the claim is not necessarily limited to the material following "may include". Furthermore, there is no antecedent basis for the terms "the nail free-edge" or "the smile line" in lines 3-4 of each claim.

Claims 7 and 21: The claims contain the phrase "wherein one consistent color or raw material type includes a mold that is large enough...". It is unclear how one consistent color or raw material type can include a mold. For purposes of examination, it will be interpreted that applicant intends for these claims to describe mold limitations and not necessarily color or material type details.

Claims 8 and 22: The claims contain two sentences. Note that claim(s) must be in one sentence form only. It is unclear whether applicant intends to claim the subject matter in the second sentence as part of his invention. For purposes of examination, it will be interpreted that subject matter in the second sentence is not required as part of the claimed invention.

Claims 9 and 23: The claims contain the phrase "thus changing the parameters of the manufactured nail blank to allow for such an object to be successfully removed...". It is unclear whether changing the parameters of the manufacture nail blank is a positively-claimed step of applicant's invention. For purposes of examination, it will be interpreted that this element is not necessarily required as part of the claimed invention.

Regarding Claims 13 and 27: The claims contain the phrase “material of the same type but may be distinguished by color, chemical properties, characteristics, or other distinguishing factors...”. It is unclear whether applicant intends to limit the claim to the factors listed. For purposes of examination, it will be interpreted that the claim is not necessarily limited to the listed factors. Further, the phrase “other distinguishing factors” is unclear because there are practically an infinite amount of “other distinguishing factors”.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (U.S. Patent 5,944,027). Regarding Claims 1 and 15, Chang shows that it is known to carry out a method to manufacture an artificial nail blank (Abstract) comprising choosing a desired raw material blank type to manufacture (Column 5, lines 35-49); and determining the mold to utilize in the creation of the desired blank (Column 5, lines 53-61); and injecting the raw material into the mold (Column 5, lines 63-67); and injecting multiple raw materials into separate molds and fusing the separate mold results together to form one nail blank (Column 6, lines 1-19).

Regarding Claims 2 and 16, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein choosing a desired raw material includes raw materials comprising plastic

where the plastics may be thermoplastic resin or thermoset types (Column 5, lines 35-49).

Regarding Claims 3 and 17, Chang shows the process as claimed as discussed in the rejection of Claim 2 above, including a method wherein choosing a desired raw material includes the ability to choose any color or combination of colors (Column 5, lines 41-49).

Regarding Claims 4 and 18, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein determining the mold to use includes determining if the nail blank will have an artistic enhancement or be all of one consistent color or raw material type (Column 5, lines 50-67; Column 6, lines 31-49).

Regarding Claim 5 and 19, Chang shows the process as claimed as discussed in the rejection of Claim 4 above, including a method wherein an artistic enhancement includes a mold design that conforms to the curvature of the nail tip (Figures 4-5).

Regarding Claims 6 and 20, Chang shows the process as claimed as discussed in the rejection of Claim 4 above, including a method wherein the artistic enhancement may include customized or personalized designs with regard to the curve of the tip of the nail along the nail smile line (Column 5, lines 6-23; Column 6, lines 31-48).

Regarding Claims 7 and 21, Chang shows the process as claimed as discussed in the rejection of Claim 4 above, including a method wherein one consistent color or raw material type includes a mold that is large enough to cut out an artificial nail object consisting of the entire color or raw material type (Column 5, lines 50-67; Column 6, lines 1-30).

Regarding Claims 8 and 22, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein determining the mold to use includes a decision regarding how many nail

objects will be cut out of the manufactured nail blank (Figures 4-5; Column 5, lines 50-67; Chang shows a decision to make one nail object.).

Regarding Claims 9 and 23, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein determining the mold to use includes using parameters of the manufactured nail blank to allow for such an object to be successfully removed from it without damaging the nail objects characteristics or intruding upon any other number of individual nail objects to be removed from the manufactured nail blank (Column 5, lines 50-67; Column 6, lines 1-30; It is noted that the specific dimensions cited for the mold do not appear to have any stepwise affect on the process.).

Regarding Claims 10 and 24, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein injecting the raw material into the mold includes applying force to the raw material in a state where the raw material will reshape to conform to the mold selected (Column 5, lines 50-67).

Regarding Claims 11 and 25, Chang shows the process as claimed as discussed in the rejection of Claim 10 above, including a method wherein injecting raw material into a mold may be accomplished by injection molding (Column 5, lines 50-67).

Regarding Claims 12 and 26, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein multiple injections includes forcing raw material into the mold for the first injection and then forcing a different raw material into the mold or a second mold to create the desired nail blank (Column 5, lines 50-67; Column 6, lines 1-19).

Regarding Claims 13 and 27, Chang shows the process as claimed as discussed in the rejection of Claim 12 above, including a method wherein forcing a different raw material into the mold or a second mold includes



material of the same type but may be distinguished by color or chemical properties (Column 5, lines 35-49).

Regarding Claims 14 and 28, Chang shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein fusing separate mold results into one manufactured nail blank includes the process of creating a better mating surface of the first mold by heating and pressure bonding so that the raw material will merge into one nail blank results while maintaining any desired artistic enhancement (Column 6, lines 1-30; It is noted that injection molding processes include application of heat and pressure to the molding material.).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to molding multilayer articles in general:

U.S. Patent 5,968,302 to Gifford

U.S. Patent 5,908,035 to Carroll et al.

U.S. Patent 4,805,645 to Schiff et al.

U.S. Patent 4,587,983 to Wissman et al.

U.S. Patent 6,382,217 to Coker et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Monica A. Huson". The signature is fluid and cursive, with the first name "Monica" being more prominent than the last name "Huson".

Monica A Huson

May 30, 2006